

Appl. No. 10/651,846
Amdt. dated December 8, 2005
Reply to Office action of September 8, 2005

REMARKS

Reconsideration of this application is respectfully requested in light of the above amendments and the following remarks. After the amendments detailed above, claims 1, 4-6 and 8-15 are pending in this application. In particular, claims 1, 6, 8-9 and 12 have been amended, claims 2, 3 and 7 have been canceled and claims 4-5, 10-11 and 13 have been maintained in their previous form. New claims 14 and 15 have been added.

I. Claims Rejected Under 35 U.S.C. § 112

Claim 1

The Examiner rejects claim 1 under 35 U.S.C. § 112, second paragraph, as being indefinite stating: the term "capable of" renders the claim indefinite. This rejection is moot as claim 1 has been amended.

Specifically, claim 1 has been amended to recite "a personality module, the personality module including at least one port for communicating with at least one field device, the personality module adapted to communicate with a server." The phrase "adapted to" defines the patentable subject matter with a reasonable degree of particularity and distinctness, and indicates that the limitation following the phrase, namely communication with a server, is part of the claimed invention. MPEP § 2173.02.

Therefore, Applicant's amended claim 1 reciting "a personality module, the personality module including at least one port for communicating with at least one field device, the personality module adapted to communicate with a server" is not indefinite and should be allowed.

II. Claims Rejected Under 35 U.S.C. § 102

Claim 1

Claim 1 was rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,522,044 to Pascucci et al. Applicant has amended independent claim 1 to further recite: "wherein the personality module operates autonomously from the server, the

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personality module includes resources comprising: a processor, a local memory, facilities management information stored on the local memory, and an application stored on the local memory and executed by the processor, the application operable to receiving communications from the at least one field device, accessing the facilities management information, and issuing commands to the at least one field device independent of the server." Pascucci does not expressly or inherently disclose each element in amended independent claim 1. Thus, Applicant respectfully requests that the Examiner withdraw the Section 102(b) rejection with respect to claim 1.

"Anticipation requires the disclosure in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim." Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)). As set forth below, Pascucci fails to disclose at least one element recited in each of the claims.

A facilities management system can be used to control industrial and environmental systems. Such a system can be automated to operate independently or be interconnected to form a network. Pascucci discloses a networked system having a wide variety of applications applicable to facilities management systems with multiple levels of software and numerous processing nodes (abstract). The Examiner equates Pascucci's processing nodes connected to a network capable of communicating with other devices on the network and also equipped with ports to connect to devices to control the operation of those devices (abstract) to Applicant's "personality module, the personality module including at least one port for communicating with at least one field device, the personality module adapted to communicate with a server." The Examiner further equates Pascucci's processing nodes being able to operate independently (column 1, lines 12-16) to Applicant's "personality module operates autonomously from the server." In response, Applicant has amended independent claim 1 to more clearly recite that "the personality module includes resources comprising a processor, a local memory, facilities management information stored on the local memory, and an application stored on the local memory and executed by the processor, the application operable to receiving communications from the

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at least one field device, accessing the facilities management information, and issuing commands to the at least one field device independent of the server." As such, Pascucci does not disclose each element of amended independent claim 1.

Pascucci teaches a data link layer and a network layer for processing and transmitting request messages received from configured and non-configured devices (column 54, lines 29-67). In Pascucci, when a request is received at any given processing node from a configured or non-configured field device, the message is initially tagged by a forwarding node so that receipt can be acknowledged (column 54, lines 29-37). The tagged message is then evaluated for its validity (column 54, lines 37-45). If the tagged message is valid, then the data link layer transmits an acknowledgement of receipt of the message to the forwarding node (column 54, lines 45-49). Subsequently, the message is tested at a network layer to determine if the destination process is located at the receiving configured node, or if it needs to be transmitted to another processing node (column 54, lines 49-67). Although Pascucci discloses processing nodes being able to operate independently, they are nevertheless interconnected to a network in order to process request messages from configured and non-configured field devices. The data link layer and the network layer are necessary and essential to Pascucci's networked facilities management system, because they are the critical intermediary components in determining the destination processing node for the requested message (column 54, lines 29-67). Accordingly, there is no motivation or suggestion to remove the data link layer and the network layer from Pascucci's networked facilities management system since they play an express purpose in his networked facilities management system. In contrast, Applicant's amended independent claim 1 recites a personality module including an application operable to "receiving communications from the at least one field device, accessing the facilities management information, and issuing commands to the at least one field device independent of the server," because the facilities management information may be stored within an associated local memory of the personality module for quick response without communicating with the server. Since Applicant's system for facilities management control comprises a personality module that can operate autonomously independent of the server as recited in amended independent claim 1, Pascucci does not expressly or inherently

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disclose each element of amended independent claim 1. Accordingly, the Applicant respectfully requests that the Examiner withdraw the Section 102 rejection in view of Pascucci.

Claims 2 and 3

Claims 2 and 3 were rejected under 35 U.S.C. § 102(b) as being anticipated by Pascucci. These rejections are moot as claims 2 and 3 have been canceled.

Claim 12

Claim 12 was rejected under 35 U.S.C. § 102(b) as being anticipated by Pascucci. Applicant has amended independent claim 12 to further recite: "a personality module management application stored on the memory, wherein the personality module management application is operable to receiving communications from any field device, accessing all facilities management information, and issuing commands to any field device independent of a system server." Pascucci does not expressly or inherently disclose each element in amended independent claim 12.

The arguments made above with respect to claim 1 regarding the applicability of the Pascucci reference apply with equal force here. See discussion *supra*. Since Applicant's system for facilities management includes a personality module management application operable to functioning independent of a system server as recited in amended independent claim 12, Pascucci does not expressly or inherently disclose each element of amended independent claim 12. Accordingly, the Applicant respectfully requests that the Examiner withdraw the Section 102 rejection in view of Pascucci.

III. Claims Rejected Under 35 U.S.C. § 103

Claims 4 and 5

Claims 4 and 5 were rejected under 35 U.S.C. § 103(a) as being unpatentable in view of Pascucci. As discussed above, Pascucci does not disclose or teach all of the elements recited in amended independent claim 1. See discussion *supra*. Therefore,

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Applicant respectfully asserts that these claims are not obvious in view of Pascucci, since these dependent claims depend from and further limit amended independent claim 1.

Furthermore, the Examiner states that properties and characteristics for the disclosed system recited in rejected claims are not explicitly taught by Pascucci, but that such claimed properties and characteristics are still obvious in view of Pascucci. However, Applicant respectfully requests that, since the Examiner admits Pascucci does not explicitly teach these limitations, the Examiner point to a specific teaching or basis to support the rationale for rejecting these claims as obvious. Applicant respectfully asserts that the burden of initially establishing a *prima facie* case of obviousness still rests with the Examiner. As a result, the Examiner offers no scientific basis or rationale to support the assertion that the claimed properties or characteristics would be automatically known to one of ordinary skill in the art when practicing the system disclosed in Pascucci, and a mere statement to that effect is not sufficient. To accept such an assertion is to say that the claimed properties and characteristics are necessarily present in Pascucci's networked facilities management system when no proof to that effect has been provided or cited. MPEP §§ 2144.02-2144.03.

For at least these reasons, Pascucci does not teach or suggest all of the elements of amended independent claim 1, from which the rejected dependent claims 4 and 5 depend, and a *prima facie* case of obviousness of all of the rejected claims has not been presented. Thus, Applicant respectfully requests that the Examiner withdraw the Section 103 rejections.

Claims 6-8

Claim 6 was rejected under 35 U.S.C. § 103(a) as being unpatentable in view of Pascucci. Applicant has amended independent claim 6 to further recite: "wherein the personality module includes resources for operating autonomously from the server, the resources comprising: a processor, a local memory, facilities management information stored on the local memory, and an application stored on the local memory and executed by the processor, the application operable to receiving communications from the at least one field device, accessing the facilities management information, and issuing commands

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to the at least one field device independent of the server." Pascucci does not disclose or teach all of the elements recited in amended independent claim 6. The arguments made above with respect to claim 1 regarding the applicability of the Pascucci reference apply with equal force here. See discussion *supra*. Since Applicant's system for facilities management includes an application operable to functioning independent of the server as recited in amended independent claim 6, Pascucci does not disclose or teach all of the elements of amended independent claim 6. Accordingly, the Applicant respectfully requests that the Examiner withdraw the Section 103 rejection in view of Pascucci.

Claim 7 was rejected under 35 U.S.C. § 103(a) as being unpatentable in view of Pascucci. This rejection is moot as claim 7 has been canceled.

Claim 8 was rejected under 35 U.S.C. § 103(a) as being unpatentable in view of Pascucci. Applicant has amended claim 8 for grammatical reasons and not for reasons related to patentability. As discussed above, Pascucci does not disclose or teach all of the elements recited in amended independent claim 6. See discussion *supra*. Therefore, Applicant respectfully asserts that this claim is not obvious in view of Pascucci, since this dependent claim depends from and further limits amended independent claim 6. The arguments made above with respect to claims 4 and 5 regarding the applicability of the Pascucci reference apply with equal force here. See discussion *supra*. For at least these reasons, Pascucci does not teach or suggest all of the elements of amended independent claim 6, from which the rejected amended dependent claim 8 depends, and a *prima facie* case of obviousness of this rejected claim has not been presented. Thus, Applicant respectfully requests that the Examiner withdraw the Section 103 rejection.

Claims 9-11

Claim 9 was rejected under 35 U.S.C. § 103(a) as being unpatentable in view of Pascucci. Applicant has amended independent claim 9 to clearly recite: "A method of performing access control, comprising: storing facilities management information in a local database; receiving signals from a field device; accessing the facilities management information; and sending the field device control signals based on the facilities management information." Pascucci does not disclose or teach all of the elements recited

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in amended independent claim 9. The arguments made above with respect to claim 1 regarding the applicability of the Pascucci reference apply with equal force here. See discussion *supra*. Since Applicant's method of performing access control excludes receiving facilities management information from a server, Pascucci does not disclose or teach all of the elements of amended independent claim 9. Accordingly, the Applicant respectfully requests that the Examiner withdraw the Section 103 rejection in view of Pascucci.

Claims 10 and 11 were rejected under 35 U.S.C. § 103(a) as being unpatentable in view of Pascucci. As discussed above, Pascucci does not disclose or teach all of the elements recited in amended independent claim 9. Therefore, Applicant respectfully asserts that these claims are not obvious in view of Pascucci, since these dependent claims depend from and further limit amended independent claim 6. The arguments made above with respect to claims 4 and 5 regarding the applicability of the Pascucci reference apply with equal force here. See discussion *supra*. For at least these reasons, Pascucci does not teach or suggest all of the elements of amended independent claim 9, from which the rejected dependent claims 10 and 11 depend, and a *prima facie* case of obviousness of these rejected claims have not been presented. Thus, Applicant respectfully requests that the Examiner withdraw the Section 103 rejection.

Claim 13

Claim 13 was rejected under 35 U.S.C. § 103(a) as being unpatentable in view of Pascucci. As discussed above, Pascucci does not disclose or teach all of the elements recited in amended independent claim 12. See discussion *supra*. Therefore, Applicant respectfully asserts that this claim is not obvious in view of Pascucci, since this dependent claim depends from and further limits amended independent claim 12. The arguments made above with respect to claims 4 and 5 regarding the applicability of the Pascucci reference apply with equal force here. See discussion *supra*. For at least these reasons, Pascucci does not teach or suggest all of the elements of amended independent claim 12, from which the rejected dependent claim 13 depends, and a *prima facie* case of obviousness of this rejected claim has not been presented. Thus, Applicant respectfully

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requests that the Examiner withdraw the Section 103 rejection.

IV. Conclusion

Amended independent claims 1, 6, 9 and 12 patentably define over the cited reference and are now in condition for allowance. Since claims 4-5, 8, 10-11 and 13-15 depend from and further limit the amended independent claims, these claims are also in condition for allowance.

It is respectfully submitted that the application is now in condition for allowance and, accordingly, reconsideration and allowance are respectfully requested. Should any questions remain regarding the allowability of the application, the Examiner is invited to contact the undersigned at the telephone number indicated below.

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The Commissioner is hereby authorized to charge any deficiency or credit any overpayment of fees which may be required by this paper to Deposit Account No. 502466 including any fee for extension of time, or the fee for additional claims which may be required. Please show our docket number with any Deposit Account transaction. A copy of this letter is enclosed.

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